

REMARKS

Reconsideration of this application in view of the above amendments and following remarks is respectfully requested.

Claims 1, 2, 4 and 8-35 are now pending. Claims 1, 2, 4, 30 and 31 have been amended. Claims 3 and 5-7 have been canceled.

As an initial matter, Applicants have amended claim 1 in a manner consistent with the outstanding Restriction Requirement. More specifically, Applicants have replaced the structural formula of claim 1 with the more specific structures of claims 2 and 4. Further, Applicants have canceled claims 3 and 5-7, while reserving the right to continue prosecution of this canceled subject matter in one or more divisional applications.

In the Office Action of September 24, 2003, the Examiner rejected claim 1 (as well as claims 8-35) as being drawn to an improper Markush group with regard to the "N=(C)₁₋₂" and "X" variables. Applicants assume that, by amending claim 1 in the manner noted above, this ground of rejection has been obviated. If Applicants' assumption is incorrect, the Examiner is respectfully requested to explain the basis of the rejection in greater detail.

Applicants note that all the pending claims stand free of the art. However, the Examiner has rejected the pending claims as indefinite under the second paragraph of 35 U.S.C. §112. For purpose of convenience, Applicants will address each these rejections in the order set forth in the Office Action at pages 3-5.

(a) The Examiner considers the term aromatic C₃₋₁₂ heterocycle to be indefinite, particularly with regard to C₃ and C₅ rings. Applicants respectfully disagree.

As defined in the specification at page 7, lines 11-12, the term "C₃₋₁₂ heterocycle" represents a ring made up of more than one kind of atom, and which contains 3 to 12 carbon atoms. Since such heterocycles contain at least 3 carbon atoms, and also contain at least one non-carbon atom (for example, a nitrogen atom), the "smallest" heterocycle of this application contains at least 4 atoms (*i.e.*, 3 carbon atoms and a non-carbon atom, such as nitrogen).

Under the definition of "Ar" in claim 1, aromatic C₃₋₁₂ heterocycles are recited. As one skilled in this field would readily appreciate, such compounds are the aromatic subset of C₃₋₁₂ heterocycles. Again, one skilled in this field would readily recognize whether any given

ring system qualified as a C₃₋₁₂ heterocycle (as that term is defined in the specification), and whether it was aromatic or non-aromatic.

Lastly, and in specific reference to the Examiner's question concerning aromatic C₃ and C₅ heterocycles, a representative aromatic C₃ heterocycle is triazinyl (with 3 carbon atoms and 3 nitrogen atoms), while a representative aromatic C₅ heterocycle is pyridinyl (with 5 carbon atoms and 1 nitrogen atom).

(b) As properly noted by the Examiner, Applicants now have amended claims 2 and 4 by inclusion of a period at the end of the sentence.

(c) Claim 27 recites R₁ as -CH(CH₂CH₃)(CH₂Obenzyl), which the Examiner considers lacks proper antecedent basis with regard to the "CH₂Obenzyl" portion thereof. To obviate this ground of rejection, Applicants have amended the definition of R₅ in claim 1 to include CH₂Obenzyl (*i.e.*, R₁ is -CH(R₄)(R₅), and the CH₂Obenzyl moiety corresponds to the R₅ group of R₁). Support for this amendment may be found in the specification at, for example, page 13, last 10 lines of Table 1 (which identifies the R₅ portion of R₁ as CH₂Obenzyl).

(d) Composition claim 30 and method of treatment claim 31 stand rejected for the reasons set forth in the Office Action at pages 3-5.

With regard to claim 30, Applicants have amended the preamble of this claim to recite a "composition comprising", as opposed to a "pharmaceutical composition comprising". While this amendment actually results in a broadening of claim 30, Applicants submit that, should the Examiner consider the compounds of claim 1 to be patentable, a composition comprising one or more of such compounds is patentable for the same reasons. (Further, use of the term "pharmaceutically" in conjunction with the carrier or diluent is appropriate, and one skilled in this field would readily appreciate the same.)

As for claim 31, Applicants strongly disagree with the Examiner's position. However, in order to expedite allowance of claims 1-30, as well as method claims 32-35 (which claims have not been rejected on this basis), Applicants have amended claim 31 to recite the specific indications of dependent claims 32-35. Further, Applicants have amended claim 31 to recite administration of the composition of claim 31 (as opposed to the pharmaceutical composition of claim 31).


According, Applicants respectfully request that the pending claims as amended herein satisfy the second paragraph of §112, and request that this ground of rejection be withdrawn.

In view of the above amendments and remarks, allowance of claims 1, 2, 4 and 8-35 is respectfully requested. A good faith effort has been made to place this application in condition for allowance. However, should any further issue require attention prior to allowance, the Examiner is requested to contact the undersigned at (206) 622-4900 to resolve the same.

Respectfully submitted,

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